

REMARKS

By this Amendment, Applicant amends claim 8. Claims 8-10 remain pending in this application.

In the Final Office Action,¹ the Examiner rejected claims 8-10 under 35 U.S.C. § 103(a) as being unpatentable over Taivitie et al. (U.S. Patent No. 6,133,884) in view of Klatt et al. (U.S. Patent No. 5,877,488). Applicant respectfully traverses the rejection for at least the following reasons.

To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8th ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. See M.P.E.P. § 2143 (8th ed. 2001).

Claim 8, as amended, recites a data processing apparatus including, among other things, "a first antenna terminal connected to the antenna and configured to connect the antenna to a second antenna terminal incorporated in the IC card when the

¹ The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Final Office Action.

IC card is inserted in the card slot, wherein the first antenna terminal and the second antenna terminal become connected upon the insertion of the IC card into the card slot.” Taivitie and Klatt, whether taken alone or in combination, do not disclose or suggest at least this element of claim 8.

With regard to the recitation in claim 8 that the first antenna terminal is “configured to connect the antenna to a second antenna terminal incorporated in the IC card when the IC card is inserted in the card slot,” in the Response to Arguments/Amendment section of the Final Office Action, the Examiner alleges Taivitie discloses that “the PCMCIA [card] ... [is] connected with [a] first antenna and second antenna for incorporating transferring data [to] each other as the PCMCIA card is plugged in the antenna units,” citing Fig. 5 and col. 5, line 66 to col. 6, line 60 (emphasis omitted). See Final Office Action, page 3. Applicant disagrees that this teaching of Taivitie discloses or suggests claim 8. Instead, as disclosed by Taivitie in Fig. 5, antenna module 40 is separate from PCMCIA card 50. Further, antenna module 40 becomes connected to PCMCIA card 50 when it is installed into antenna socket 51, not when PCMCIA card 50 is removed from a card slot. However, connecting antenna module 40 to PCMCIA card 50 does not constitute or suggest “a first antenna terminal connected to the antenna and configured to connect the antenna to a second antenna terminal incorporated in the IC card when the IC card is inserted in the card slot, wherein the first antenna terminal and the second antenna terminal become connected upon the insertion of the IC card into the card slot,” as recited in claim 8 (emphasis added).

The Examiner also appears to contend that Taivitie teaches a card and antenna that are connected “as the PCMCIA card is plugged in the antenna units” (emphasis omitted). See Final Office Action, page 3. In making this contention, the Examiner appears to correlate connection of the antenna units (antenna module 40 or antenna connector 30 shown in Fig. 5 of Taivitie) to PCMCIA card 50 with Applicant’s recitation in claim 8 of “a first antenna terminal configured to connect the antenna to a second antenna terminal incorporated in the IC card when the IC card is inserted in the card slot.” However, the correlation is not appropriate because antenna module 40 or antenna connection 30 do not become connected to PCMCIA card 50 when PCMCIA card 50 is inserted into a card slot. By contrast, as recited in claim 8, the “first antenna terminal connected to the antenna ... [is] configured to connect the antenna to a second antenna terminal incorporated in the IC card when the IC card is inserted in the card slot, wherein the first antenna terminal and the second antenna terminal become connected upon the insertion of the IC card into the card slot” (emphasis added). Taivitie does not teach or suggest at least this element. Accordingly, Taivitie does not disclose or suggest claim 8.

Moreover, Klatt does not compensate for the above discussed deficiencies of Taivitie. As shown in Fig. 1 of Klatt, and described in the passages relied upon by the Examiner in the Final Office Action (col. 4, line 66 through col. 5, line 56), Klatt discloses that “chip card 9 can be inserted in the direction of the shown double arrow into the contacting unit 1.” See col. 5, lines 16-18. However, the chip card reader shown in Klatt also does not disclose or suggest a “first antenna terminal connected to the antenna and configured to connect the antenna to a second antenna terminal

incorporated in the IC card when the IC card is inserted in the card slot, wherein the first antenna terminal and the second antenna terminal become connected upon the insertion of the IC card into the card slot," as recited in claim 8. Since Klatt does not make up for the deficiencies of Taivitie, the cited references, whether taken alone or in combination, do not disclose or suggest claim 8. Accordingly, the Examiner has not established a *prima facie* case of obviousness and Applicant requests the Examiner to withdraw the rejection of claim 8 under 35 U.S.C. § 103(a).

Claims 9 and 10, which depend from claim 8, are also not obvious in view of the cited references, whether taken alone or in combination, at least due to their dependence. Therefore, Applicant also requests the Examiner to withdraw the rejection of claims 9 and 10 under 35 U.S.C. § 103(a).

CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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